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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,887	07/16/2001	Yoshinori Hama	211456US0	3676

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/04/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/904,887		HAMA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Callie E. Shosho		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

**Claim Rejections - 35 USC § 102**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Uraki et al. (U.S. 6,031,024).

Uraki et al. disclose process for preparing aqueous dispersion comprising the steps of mixing pigment, polymer, and solvent, adding this mixture to water, removing solvent, and then subjecting solvent removed product to dispersion treatment, i.e. milling (example 4). There is also disclosed a water-based ink composition comprising the above aqueous dispersion.

In light of the above, it is clear that Uraki et al. anticipate the present claims.

3. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimomura et al. (U.S. 5,837,754).

Shimomura et al. disclose process for preparing aqueous dispersion comprising the steps of (i) dissolving polymer, i.e. polyester resin, in solvent followed by adding water or simultaneously mixing polymer, solvent, and water followed by (ii) removing solvent to form aqueous dispersion. The solvent removed product is then stirred to form microdispersion. It is disclosed that the polymer can be dispersed in aqueous medium after being colored with pigment, the polymer can be colored with pigment while being dispersed in aqueous medium, or the polymer can be colored after dispersion in aqueous medium. There is also disclosed a water-based ink composition comprising the above aqueous dispersion (col.8, lines 57-62, col.8, line 67-col.9, line 5, col.9, lines 10-13 and 62, and col.10, lines 44-51).

From the above, it is clear that Shimomura et al. encompasses processes wherein (a) pigment, polymer, solvent, and water are mixed followed by removing solvent, (b) polymer, solvent, and water are mixed with pigment followed by removing solvent, and (c) polymer, solvent, and water are mixed, followed by removing solvent, and then adding pigment wherein each of the solvent removed products is then subjected to dispersion treatment.

In light of the above, it is clear that Shimomura et al. anticipate the present claims.

4. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsutsumi et al. (U.S. 6,031,019).

Tsutsumi et al. disclose process for making aqueous dispersion comprising the steps of adding polymer and colorant to solvent to form mixture, adding neutralizer and water to mixture, removing solvent, and then subjecting solvent removed product to dispersion treatment. There is

also disclosed a water-based ink comprising the above dispersion (col.12, line 61-col.13, line 4 and preparation example 1 and example 1).

In light of the above, it is clear that Tsutsumi et al. anticipate the present claims.

5. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08218013.

Pending translation, it is noted that JP 08218013 disclose process for making aqueous dispersion comprising the steps of blending (i) solution of polymer and pigment produced by dispersing resin and neutralizer in solvent followed by adding pigment with (ii) water, removing solvent from the produced blend, and then subjecting solvent removed product to dispersion treatment. There is also disclosed a water-based ink comprising the above dispersion.

In light of the above, it is clear that JP 08218013 anticipate the present claims.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Song et al. (U.S. 6,372,824).

Song et al. disclose process for making aqueous dispersion comprising the steps of mixing polymer, solvent, and water to produce mixture, removing an organic solvent from the mixture, adding pigment, and then subjecting solvent removed product to dispersion treatment (col.5, lines 32-42 and 54-67, col.9, lines 16-24, and col.10, lines 9-17).

In light of the above, it is clear that Song et al. anticipate the present claims.

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7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chung et al. (U.S. 6,476,102) disclose process for making aqueous dispersion, however, given the effective filing date, this reference is not applicable as prior art under any subsection of 35 USC 102.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Callie E. Shosho  
Examiner  
Art Unit 1714

CS  
November 26, 2002